

### **REMARKS**

This amendment and related remarks that follow are intended to place the subject application in condition for allowance. Amendments to the claims are presented starting on page 3. Specifically, claims 1, 12, 25 and 32 are amended per the Examiner's recommendation and also to better claim the Applicants' invention. In view of these amendments and the following reasoning for allowance, the Applicants hereby respectfully request further examination and reconsideration of the subject application.

#### **1. Rejection of Claims 1-32 Under 35 USC §112**

The aforementioned Office Action of January 5, 2006 rejected claims 1-32 of the subject application under 35 USC §112, first paragraph, stating that the specification does not provide enablement for the claim language "automatically correct any/the conflicts" used in claims 1, 12, 25 and 32. In order to overcome this rejection these claims are amended herein per the recommendation supplied by the Examiner. The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 1-32, under 35 USC §112, first paragraph.

#### **2. Rejection of Claims 1-9, 12-22, 25-28, 30 and 32 Under 35 USC §103(a)**

The aforementioned Office Action of January 5, 2006 rejected claims 1-9, 12-22, 25-28, 30 and 32 of the subject application under 35 USC §103(a) as being obvious over Bull et al. (US Patent No. 5,901,287 – hereafter Bull) in view of Gifford (US Patent No. 4,845,658) and Moss et al. (US Patent No. 5,485,370 – hereafter Moss). More particularly, it was stated that the combination of Bull and Gifford teaches all the elements of independent claims 1, 12, 25 and 32 except "preventing the user from encountering conflicts by using client-side processing to prevent/correct any conflicts," but that Moss teaches "preventing the user from encountering input errors, which reads on conflicts, by using client-side processing to prevent/correct any conflicts," and that it would have been obvious to add the teachings of Moss to those of Bull and Gifford. The Applicants respectfully disagree with this assertion for the following reasons.

As an introductory point of note, the subject application incorporates by reference U.S. Application Serial No. 09/157,018, filed by Lamb et al. (hereafter Lamb) on September 18, 1998, which has since been issued as U.S. Patent No. 6,803,926. (refer to subject application page 19, lines 9-13)

The Applicants claim methods, a display device, and a computer-readable medium having computer-executable instructions (hereafter simply referred to as a system and methods) for displaying and adjusting personalized information on a client system, whereby, in response to an initial query for information initiated by a user at the client, a server receives and processes the query, and "produces personalized results comprised of data values specifically relating to the query," wherein, "the results can also include sub-items and rules of enforcement of sub-item combinations." (refer to subject application page 13, lines 7-16) The server then transmits the results, sub-items and rules of enforcement of sub-item combinations across the network back to the client. (refer to subject application page 14, lines 4-5) Via client-side processing, the "results are dynamically adjusted and displayed" to the user at the client as data values "as the user interacts with the results and sub-items. Sub-item conflicts are prevented by enforcement of the transmitted rules of sub-item combinations and predefined interactive options" related to the results. (refer to Lamb column 2, lines 45-50) This "allows the user to interact with the data values and make adjustments to the data values with user input directed to the interactive options." (refer to Lamb column 5, lines 55-59) The "rules of enforcement ... contain all potential configurable conflicts between sub-items to thereby prevent the user from creating any sub-item conflicts during adjustment of the sub-items." (refer to Lamb column 8, lines 31-36) "All conflicts are resolved dynamically by not offering sub-items that are not related to the requested data and by automatically selecting other sub-items as a particular conflicting sub-item is selected by a client user ..." (refer to Lamb column 9, lines 19-24) Alternatively, a control module located on the client, which is either "sent from the server to the client or created dynamically on the client ... during user interaction with the data values ..., provides real-time user interactivity by controlling the transmitted results, sub-items and rules of enforcement and" also by "processing the user input for allowing dynamic manipulation of the data values and dynamic prevention of data

value conflicts." (refer to subject application page 14, lines 12-19 and also to Lamb column 5, lines 59-65)

Hence, in the system and methods claimed by the Applicants the user at the client is dynamically prevented from encountering sub-item or dependency conflicts for *both* data which is input into the client by the user, *as well as* for data which is received from the network by the client, said network data being transmitted to the client by a server in response to a client query.

Moss, on the other hand, teaches a distinctly different system and method whereby a packet assembler and disassembler (PAD) element located within the "smart" version of a home terminal is "in communication with the customer input device" on the terminal and "includes means for receiving the input signals, for analyzing the input signals in accordance with input formatting rules ..., and for providing local feedback signals" which are displayed on the terminal to the customer "in accordance with the analysis." The PAD also has a "means, responsive to the input signals, for forming first packets of information ... and for transmitting the first packets of information which have no formatting errors or fewer formatting errors than the input signals." (refer to Moss column 4, lines 47-62 – also discussed in Moss column 5, lines 21-25 and 51-56, among other places) Therefore, **Moss teaches that the signal analysis and related error prevention performed by the PAD is *unidirectional* in that it operates *only* on data input by the customer into the terminal.** This is further reinforced by Moss column 25, lines 16-25 which state that "the PAD performs two types of error correction ... A second type of error correction, termed "data entry error correction", involves input of the customer's key entries, echoing characters to the terminal screen, transaction information accumulation, and data packet assembly." **Nowhere in Moss is reference ever made to signal analysis and/or error prevention/correction of any sort being performed on data received by the terminal from the network.**

In order to deem the Applicants' claims unpatentable under 35 USC §103(a), a prima facie case showing obviousness must be made. To make a prima facie case showing obviousness, *all* of the elements of the recited claims must be considered,

especially when they are missing from the prior art. If a claimed element is *not* taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Based on the arguments presented above, **neither Bull, Gifford nor Moss teach the Applicants' claimed system and methods for dynamically preventing the user at the client from encountering sub-item or dependency conflicts for *both* data which is input into the client by the user, as well as for data which is received by the client from the network**, said network data being transmitted to the client by a server in response to a client query. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 1-9, 12-22, 25-28, 30 and 32 are patentable under 35 USC 103(a) over Bull in view of Gifford and Moss. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in currently amended claim 1:

"preventing the user from encountering sub-item or dependency conflicts for both data entered into the client by the user, and for data received from the network by the client, by using client-side processing to automatically prevent the conflicts from being displayed during the user's interaction with the results, wherein a set of rules of enforcement is transmitted to said client and used as the basis for said processing, wherein said rules contain all potential configurable conflicts between sub-items that may occur during the user's interaction and corresponding safeguards to prevent the user from encountering and viewing a conflict during the user's interaction with the results;"

The aforementioned Office Action of January 5, 2006 further stated that although neither Bull, Gifford nor Moss teach that "a set of rules of enforcement (for correcting conflicts) is transmitted to said client," since Moss teaches that "the correction is accomplished within the client, so the correction rules must be within the client and any process of getting the rules into the client reads on having the rules transmitted to said client," hence, under the principles of inherency, transmitting "a set of rules of enforcement

(for correcting conflicts)" to the client is anticipated by Moss. The Applicants also respectfully disagree with this assertion for the reasons stated above. In summary, **Moss teaches that the signal analysis and related error prevention performed by the PAD is *unidirectional* in that it operates *only* on data input by the customer into the terminal. In contrast, the Applicants claim a system and methods in which the user at the client is dynamically prevented from encountering sub-item or dependency conflicts for *both* data which is input into the client by the user, *as well as* for data which is received by the client from the network. Therefore, any rules of enforcement for preventing errors that might be present in the terminal and related PAD element taught by Moss would be distinctly different from the rules of enforcement claimed by the Applicants.**

The MPEP states in Section 2112, Part IV (Edition 8, Last Revision October 2005) that:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) .... **"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."** *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)"

The Examiner has not shown that that the signal analysis and related error prevention taught by Moss, and performed by the PAD, operate on data which is received from the network by the terminal. For this reason, the Applicants respectfully disagree with the Examiner's assertion that Moss anticipates the Applicants' claimed system and process

wherein a set of rules of enforcement is transmitted to the client and used as the basis for client-side processing which automatically prevents the user from encountering sub-item or dependency conflicts for both data entered into the client by the user, and for data received from the network by the client. The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 1-9, 12-22, 25-28, 30 and 32 under 35 USC §103(a) as being obvious over Bull et al. in view of Gifford and Moss et al.

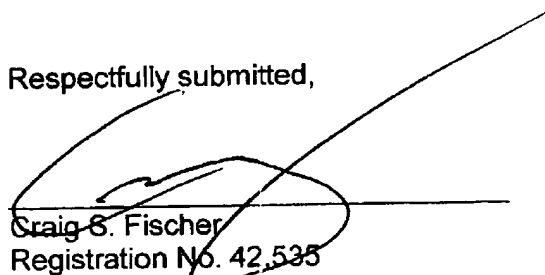
### 3. Summary

In view of the amendments and remarks presented herein, the Applicants respectfully submit that claims 1-32 of the subject application are in condition for allowance as they are both enabled by the specification and not obvious over the prior art cited by the Examiner. Accordingly, reconsideration of the rejection of these claims is respectfully requested and allowance of these claims at an early date is courteously solicited.

In an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (805) 278-8855 if the Examiner has any comments, questions or concerns, wishes to discuss any aspect of the prosecution of this application, or desires any degree of clarification of this response.

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Respectfully submitted,



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